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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/729,817	12/05/2003	Katsuaki Akama	FUJS 20, 759	2105
26304 7590 08/04/2009 KATTEN MUCHIN ROSENMAN LLP 575 MADISON AVENUE NEW YORK, NY 10022-2585				
EXAMINER				
AUGUSTIN, EVENS J				
ART UNIT		PAPER NUMBER		
3621				
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08/04/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/729,817

Applicant(s)

AKAMA, KATSUAKI

Examiner

EVENS J. AUGUSTIN

Art Unit

3621

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04/27/09.
- 2a) ☒ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 and 28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 and 28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 September 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Acknowledgements

1. ("1.This is in response to an amendment filed on August 16th, 2006. Claims 24-30 have been cancelled. Claims 1-35 are pending. Claims 1-23 and 31-35 have been examined.

Response to Arguments

2. The United States Patent and Trademark Office has fully considered the applicant's arguments filed on 04/27/2009, but has not found those arguments to be persuasive.
3. Argument 1: Applicant's central argument is that the prior art by Laor "only describes coupon information being transmitted in a redemption transaction and fails to disclose or suggest a coupon remaining after being redeemed in a transaction by an entity to which the coupon is originally issued".
4. Response 1: Firstly, with regard to the language of "a coupon remaining after being redeemed in a transaction by an entity to which the coupon is originally issued", it is not part of the claim language. Applicant correctly stated that the prior art by Laor " describes coupon information being transmitted in a redemption transaction" on page 2 of remarks, but also stated that prior art fails to "disclose or suggest any transfer of coupon" on page 1 of remarks. The PTO respectfully disagrees with this assertion. Laor teaches a single server that transmits an electronic coupon to a user in response to a user request and redeems, as well as authenticates, the electronic coupon (column 4, lines 50-67). Laor also teaches a server receiving a coupon from a user and modifying or enabling a transaction using said coupon (column/line 4/50-5/5).

Status of Claims

1. Claims 1-16 and 28 have been examined.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-16, 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jovicic et al., U.S. Patent No. 5,855,007 in view of Laor, U.S. Patent No. 6,076,069.
4. As per claims 1-16 and 28, Jovicic et al. teach an electronic transaction method comprising:
 - A. requesting an electronic coupon from a coupon server and the server transmitting the coupon comprising a value and a customer name (figure 3; column/line 6/49-7/40) to the requesting device (column 7, lines 40-45; column/line 7/55-8/17)
 - B. a customer database and recording and managing coupon owner (e.g. customer) information (figure 1, items 124 and 126; column 6, lines 3-14; column 9, lines 10-26)

- C. a redemption server changing owner information according to a transferee apparatus of said coupon (figure 4, item 422; column 7, lines 45-50; column 9, lines 23-28; column/line 10/63-11/4) –
- D. the customer transferring the coupon to a shop (column 7, lines 45-50) and also notifying the [redemption] server of the transfer (column/line 1/60-2/2; column 2, lines 30-35; column 7, lines 52-55)
- E. setting a validity term for the coupon (figure 3, item 314; column 7, lines 9-11)
- F. managing the status of the electronic coupon (figure 1, items 124 and 134; column 9, lines 10-40; column/line 10/45-11/37)
- G. [periodically] charging a user an amount corresponding to the coupon's value (figure 3, items 302 and 308; column 2, lines 25-30; column/line 6/65-7/2; column 11, lines 38-41)
- H. Jovicic also teaches an electronic coupon with real value (C6, L59-67), being used as part of a transaction. This is consistent with Webster's dictionary definition of money, which is "something generally accepted as a medium of exchange, a measure of value, or a means of payment".

However, Jovicic et al. do not specifically recite a server that records coupon owner information and also changes owner information according to a transferee apparatus. Laor teaches a single server that both transmits an electronic coupon to a user in response to a user request and redeems, as well as authenticates, the electronic coupon (column 4, lines 50-67).

Laor also teaches a server receiving a coupon from a user and modifying or enabling a transaction using said coupon (column/line 4/50-5/5). Laor teaches that alternatively, the electronic coupon can be used in transactions between two businesses, two government agencies or two governments wherein, for example, the businesses enter into an agreement relating to a transaction for goods or services or access to information, or the governmental bodies enter into an agreement relating to transactions regarding currency or information (C3, L24-30). Therefore the coupon is being used electronic money since it is used as payment instruments to complete transactions of goods/services.

5. Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Jovicic et al. and Laor (In re Wolfe, 116 USPQ 443, 444 (CCPA 1961)).
6. As per claims 5-7, Jovicic et al. teach an electronic coupon that includes a value (figure 3, items 302 and 308; column/line 6/59-7/2) and an owner identification number (figure 3, items 320 and 322). Laor teaches a unique key that can be used to validate or authenticate the coupon (column 4, lines 7-10). A remote server that stores a user signing key and signs data on behalf of the user using said key is old and well known. Further, to one of ordinary skill a unique key for authenticating and validating data is a signing key wherein the signing key is a private key of a public/private key pair. Regarding multiple keys, it has been held that an obvious modification of Laor is to use multiple keys to sign multiple data as the duplication of parts has no patentable significance unless new and unexpected result is produced (In re Harza, 124 USPQ 378 (CCPA 1960)). It has also been held that the mere arrangement of data in memory (i.e. where the signature is found in the electronic coupon) will not distinguish the

claims from the prior art (In re Gulack, 217 USPQ 401 (Fed. Cir. 1983), In re Ngai, 70 USPQ2d (Fed. Cir. 2004), In re Lowry, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP 2106.01).

7. As per claim 7, Jovicic et al. teach transferring the electronic coupon from a transferee apparatus to the server for authentication (column 7, lines 50-55). More specifically, the prior art teaches conveying the results to the transferee apparatus and the information terminal (column 2, lines 25-30; column 7, lines 50-55; column 11, lines 12-20), and redeeming a coupon (or changing the owner of the coupon) (column/line 10/62-11/3) based on the authentication process (Note: Method steps that do not have to be performed do not limit the scope of the claim or the limitation-MPEP §2106 II C).
8. As per claim 12, Jovicic et al. teach charging a user an amount corresponding to the coupon's value (figure 3, items 302 and 308; column 2, lines 25-30; column/line 6/65-7/2; column 11, lines 38-41), regarding what conditional or optional language, method steps that do not have to be performed do not limit the scope of the claim or the limitation (Intel Corp. v. Inf'l Trade Comm'n, 20 USPQ2d 1161 (Fed. Cir. 1991) MPEP §2106 II C).
9. As per claims 13-16, Jovicic et al. teach storing an electronic coupon on an information terminal (figure 2, item 218 and figure 4; column 8, lines 10-32) wherein said terminal comprises a display means (figure 2, items 214 and 218; column 8, lines 18-32). Information terminals that require a user to provide a username and password in order to access the terminal are old and well known.

Conclusion

10. **THIS ACTION IS MADE FINAL.** Any new ground(s) of rejection is due to the applicant's amendment. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
11. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.
- 12.
13. In determining patentability of an invention over the prior art, the USPTO has considered all claimed limitations, and interpreted as broadly as their terms reasonably allow. Additionally, all words in the claims have been considered in judging the patentability of the claims against the prior art.

Art Unit: 3621

14. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Evens Augustin whose telephone number is (571) 272-6860. The Examiner can normally be reached on Monday-Friday from 10:00 AM-7:00 PM.
15. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Fischer, can be reached at (571) 272-6779.

/Evens J. Augustin/
Examiner Art Unit 3621
August 4, 2009